

## **APPEAL BRIEF**

**U.S. Patent Application No. 10/671,758**

### **I. Real Party in Interest**

The real Party in interest, as evidenced by the assignment document Reel/Frame 014595/0836 recorded May 4, 2004.

### **II. Related Appeals and Interferences**

There are no other appeals or interferences known to Appellant which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **III. Status of Claims**

Claims 1-10, and 12-14 are pending. Claims 1-10, and 12-14 stand rejected and are being appealed. Claim 11 has been canceled without prejudice or disclaimer. A copy of the claims as currently pending is found in the Claims Appendix.

### **IV. Status of Amendments**

All proposed amendments have been entered. No amendments were presented after final rejection.

### **V. Summary of Claimed Subject Matter**

Independent claim 1 relates to a coextrusion tie layer which adheres to polyester, and which is a blend of

- a) 95 to 65% ungrafted metallocene polyethylene; and
- b) 5 to 35 weight % of a blend of
  - 1) 80 to 20% cografted metallocene polyethylene (density 0.863 – 0.915); and
  - cografted non-metallocene linear low density polyethylene (density 0.900 to 0.950).

The claim is fully supported by original disclosure in the Substitute Specification on Page 3, Lines 7 – 29.

Independent claim 6 relates to a multi-layer structure in which the coextrusion tie of claim 1 is attached directly to a polyolefin or polyester layer. The claim is fully supported by original disclosure on Page 4, Lines 6-10 of the Substitute Specification.

Independent claim 9 relates to an object incorporating the multi-layer structure of claim 6. The claim is fully supported by original disclosure on Page 4, Lines 19-21 of the Substitute Specification.

## **VI: Grounds of Rejection to be Reviewed on Appeal**

Ground 1: The sole ground for rejection is based on 35 U.S.C. §103(a) over Robert et al. EP 1136536 (using US 6,528,587 for translation).

The Examiner asserts that the Robert reference teaches each of Applicant's claim limitations except for failing to disclose a polyethylene homopolymer having a melt flow index between 3 and 15g/10 min. The Examiner further asserts that one of skill in the art would have recognized the utility of varying the melt flow index of the metallocene polyethylene homopolymer and the blend component to obtain the desired melt flow rate.

## **VII: Argument**

All pending- claims 1-10, and 12-14 are argued as a single group and are to stand or fall together.

Ground 1: Applicant's argument over the stated Grounds of Rejection is: It is improper to cite the foreign equivalent of a properly disclaimed US patent as prior art in the same patent application.

**Since a proper terminal disclaimer has been accepted by the USPTO, the citation of a foreign equivalent of the terminally disclaimed US patent effectively nullifies said terminal disclaimer, and is therefore improper.**

## **KEY FACTS:**

### **Present application prosecution History:**

09/27/2002 - FR 02.11992 application was filed in France as the priority document.

09/26/2003 – US patent application 10/671,758 was filed, claiming priority to FR 02.11992.

02/08/2005 – First Office Action Rejection: §112 and double patenting rejections over US 6,528,587 in view of X, as the only rejections.

4/29/2006 – A response and terminal disclaimer over US 6,528,587 with proper fees was filed.

7/26/2005 – Non-final rejection: over EP 1136536 (EP equivalent of terminally disclaimed US 6,528,587) using US 6,528,587 as the translation!

10/25/2006 – Response, claiming that a citation of the EP equivalent of the terminally disclaimed US case as prior art is improper.

01/12/2006 – Non-final rejection: over same EP 1136536 art.

06/12/2006 – Response (with 1-month extension fee) again arguing improper citation of the European equivalent of the US terminally disclaimed patent.

07/26/2006 – Final rejection, again based on EP 1136536.

09/26/2006 – A Notice of Appeal and Pre-Appeal Brief Request for Review was filed.

11/03/2006 – Notice of the Panel Decision to proceed to the Board of Patent Appeals

**Prosecution history of US 6,528,587 and European equivalent EP 1136536**

03/24/2000 – FR 0003797 was filed.

03/16/2001 - EP 1,136,536 B1 was filed. Published September 26, 2001, claiming priority to the FR 0003797 priority document.

03/26/2001 - US 6,528,587 B2 filed (first business day – Monday – after the 1-year anniversary of the priority document), and published December 20, 2001, claiming priority to the FR 0003797 priority document.

03/04/2003 – US 6,528,587 granted.

**The Examiner erred in applying the EP equivalent patent of a US terminally disclaimed patent, in substitution for said US terminally disclaimed patent.** Applicant contends that

application of a foreign equivalent after the acceptance of a terminal disclaimer of the US case:

- A. Is against the stated purpose of a Terminal disclaimer.**
- B. Is against public policy.**
- C. Is against international treaties.**

- D. Is against US Examination Procedure of Piecemeal Examination**
- E. Allows the Examiner to obtain a terminal disclaimer, then turn around and substitute the foreign equivalent of the disclaimed patent, making a mockery of the terminal disclaimer and Examination process.**
- F. Would lead to the invalidation of many current US patents.**
- G. Could provide a means for the US Patent Office to change established policy and limit terminal disclaimers, thus more closely matching International Patent Practice.**

Applicant knows of no case law on point.

Applicant acknowledges that the EP 1136536 application, published one year and one day before Applicant's priority document, could be a valid prior art reference.

Applicant notes that the Examiner in this case recognizes the equivalence of the US 6,528,587 and EP 1136536 documents – since the Examiner uses the US patent as the English translation of the EP application. The US '587 and EP '536 equivalent patents of course have the same priority document with a date of March 24, 2000.

**A. Is against the stated purpose of a Terminal disclaimer:**

If a terminal disclaimer over a US patent is not also a terminal disclaimer over all foreign equivalent cases having the same priority date, then the terminal disclaimer ceases to function in the manner anticipated by the law. The main function of the Terminal Disclaimer is that it obviates the primary objection to double patenting, which is the extension of monopoly. *In re Robeson*, 331 F.2d 610, 141 USPQ 485 (1964). To accomplish this purpose, the terminal disclaimer should place the claims in the same position with respect to the EP ('536) subject matter as the US ('587). Since the present claims now terminate with the US ('587) patent claims, there is no monopoly extension over either US ('587) or the equivalent (EP '536).

The effect of a terminal disclaimer is to tie the affected patents together [*Ortho Pharmaceutical Corp v. Smith*, 959 F.2d 936, 22 USPQ 2d 1119, 1123 (Fed. Cir 1992)]. Tying the US patent, without also tying all foreign equivalent applications having the same priority, produces an incomplete tying, thus frustrating the purpose of the terminal disclaimer.

Further, it could flow from the tying to the terminal date of a new US application to the terminal date of an earlier filed US patent that the same new US application would have an

effective priority of the earlier filed US patent – perhaps not generally, but at least as related to foreign equivalents of the earlier US case.

**B. Is against public policy:**

One important public policy purpose of a Terminal Disclaimer is that improvements are placed into the public domain sooner. In this regard, the framers of the present regulations placed no limits on length of time that can be terminally disclaimed. The effect of the Examiner's substitution of a foreign equivalent for a terminally disclaimed US patent will be to limit the use of a terminal disclaimer to applications that have not published in a foreign office more than one year before the filing of the application at bar.

The effect of a terminal disclaimer that applies only to the US patent, and not to any foreign equivalents, in effect limits the use of a terminal disclaimer for any internationally filed patent, to US cases filed less than 30 months prior to the application filing date. Foreign patent applications publish at 18 months, making the disclaimer of any US patent older than 30 months and filed internationally a useless exercise (18 months to publish, and must publish more than 12 months before US case). This allows Patent Examiners an opportunity to effectively nullify any Terminal Disclaimer of an internationally filed US patent older than 30 months by citing the foreign equivalent as prior art as a substitute.

The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. MPEP 804.02(II). *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

**C. Is against international treaties:**

The Paris Convention, in Article 4 (A) (2) provides that “Any filing that is equivalent to a regular national filing...be recognized as giving rise to the right of priority”. For references filed under the PCT, then by 35 U.S.C. §102(e) and §103(a) any international application shall have the effects of an application filed in the US. Since PCT applications are given the same

effect as US references under 35 U.S.C. §102(e), then it would follow that the same effect should apply to a terminal disclaimer over a PCT application.

Since international patent applications share priority date status by treaty, it would make sense that the terminally disclaimed US patent should also share removal as references international patent equivalents of the disclaimed US patent.

**D. Is against US Examination Procedure of Piecemeal Examination:**

MPEP 707.07(g) provides that piecemeal examination should be avoided. Once a rejection over a prior art reference has been overcome, the citation of the same reference, only filed in a different country, amounts to an undue, burdensome, replicate piecemeal examination that does not further the patenting process.

**E. Allows the Examiner to obtain a terminal disclaimer, then turn around and substitute the foreign equivalent of the disclaimed patent, making a mockery of the terminal disclaimer and Examination process.** A foreign equivalent of a US Terminally-disclaimed reference (with the same priority date) should not be allowed to be used as a substitute 35 U.S.C. §103 reference. The substitute of equivalent references makes a mockery of US Terminal Disclaimer practice, allowing Examiners to circumvent most Terminal Disclaimers. Once a US applicant decides to shorten the length of monopoly protection in exchange for removal or a prior art reference it is unfair for the Patent office to accept such a terminal disclaimer, then use a foreign equivalent patent to make the same arguments. This would amount to a Government taking of Applicant's property rights through trickery, and without any consideration.

**F. Would lead to the invalidation of many US patents**

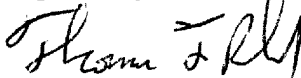
Many currently granted US patents have been allowed with terminal disclaimers to obviate prior art. Any of these granted US patents in which the terminally disclaimed patent was foreign published prior to the invention, could now be rendered invalid over the foreign equivalent patent. Applicant is concerned that this change of USPTO policy could cause havoc with several **of Applicant's granted US patents, and cause a general crisis for many other patent holders.**

**H. Could provide a means for the US Patent Office to change established policy and limit terminal disclaimers, thus more closely matching International Patent Practice.** The terminal disclaimer is unique to US patent practice. As the US strives for harmonization with world patent practices, limitation of terminal disclaimer practice in which foreign equivalent patents can be substituted for a terminally disclaimed patents would be a large first step toward the elimination of the terminal disclaimers altogether. If this is the goal of the new terminal disclaimer policy which is the subject of the present application reject and Appeal, then Applicant would encourage the USPTO to more clearly state this new policy.

### CONCLUSION

Appellant submits that the substitution of a foreign equivalent patent as a 35 USC §103(a) reference for a terminally disclaimed US patent is improper and unfair. The rejection of record should not be sustained, and the Board is requested to reverse the Examiner's rejection and pass the claimed as terminally disclaimed, to allowance at this time..

Respectfully submitted



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## **VIII: CLAIMS APPENDIX**

### Claims as they currently stand

1. A coextrusion tie, which comprises:

- 5 to 35% by weight of a polymer (A) itself composed of a blend of 80 to 20% by weight of a metallocene polyethylene (A1) with a density of between 0.863 and 0.915 and of 20 to 80% by weight of a non-metallocene LLDPE polyethylene (A2) with a density of between 0.900 and 0.950, the blend of polymers (A1) and (A2) being cografted by a grafting monomer chosen from unsaturated carboxylic acids and their derivatives, the content of the grafting monomer in said blend being between 30 and 100 000 ppm, preferably between 600 and 5 000 ppm;
- 95 to 65% by weight of metallocene polyethylene (B) homo- or copolymer, the comonomer of which comprises 3 to 20 carbon atoms, the density of which is between 0.863 and 0.915 and the MFI, melt flow index, of which, measured under 2.16 kg at 190°C according to Standard ASTM D 1238, is between 0.5 and 30, g/10 min;

the total forming 100%, the blend of (A) and (B) being such that its MFI is between 0.1 and 15, g/10 min.

2. The tie as claimed in claim 1, the adhesive strength of which is increased by 5 to 50% between the time  $t=0$  corresponding to its application immediately after its extrusion and the time  $t=8$  days.
3. The tie as claimed in claim 1, wherein the grafting monomer is maleic anhydride.
4. The tie as claimed in claim 1, which additionally comprises an ethylene/alkyl (meth)acrylate copolymer (C).
5. The tie as claimed in claim 1, wherein the MFI of A is between 0.1 and 5 g/10 min (ASTM D 1238 at 190°C under 2.16 kg).



6. A multilayer structure, which comprises a layer (L) comprising the tie of any one of the preceding claims and a layer (E) directly attached to one of the two faces of said layer (L), said layer (E) being a polyolefin or polyester layer.
7. The multilayer structure as claimed in claim 6, wherein a layer (F) is directly attached to the second face of the layer (L), the layer (L) being sandwiched between the layers (E) and (F), said layer (F) being either a polymer layer, the polymer being chosen from the group of the polyamides, saponified copolymers of ethylene and of vinyl acetate (EVOH), polyolefins and polyesters, or a metal layer.
8. The multilayer structure as claimed in claim 7, wherein the layer (E) is a polyester copolymer layer and the layer (F) is an EVOH layer.
9. An object, which comprises a structure as claimed in claim 6.
10. The object as claimed in claim 9, which is a bag, a bottle, a container, a film, a sheet, a pipe or a hose.
11. (canceled)
12. The coextrusion tie of claim 1 wherein said metallocene polyethylene (B) copolymer comonomer comprises 4 to 8 carbon atoms.
13. The coextrusion tie of claim 1 wherein said metallocene polyethylene (B) has an MFI, melt flow index, of which, measured under 2.16 kg at 190°C according to Standard ASTM D 1238, is between 3 and 15, g/10 min.
14. The coextrusion tie of claim 1 wherein the blend of (A) and (B) being such that its MFI is between 1 and 13 g/10 min.

**IX: EVIDENCE APPENDIX**

No evidence under §§ 1.130, 1.131, or 1.132 was entered in this application.

**X: RELATED PROCEEDINGS APPENDIX**

No related proceeding were identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. §41.37.